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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,347	11/19/2001	Yuichiro Ogawa	109808	8515
25944	7590	10/06/2003	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			KNABLE, GEOFFREY L	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/988,347	Applicant(s) OGAWA ET AL.	
	Examiner Geoffrey L. Knable	Art Unit 1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 and 9-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>8</u> . | 6) <input type="checkbox"/> Other: |

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-4, drawn to a method for manufacturing a tire characterized by winding a rubber strip on an outer surface of an expanded carcass, classified in class 156, subclass 117.
 - II. Claims 5-7, drawn to a method for manufacturing a tire characterized by applying a belt and winding a strip on an outer surface of the belt, classified in class 156, subclass 130.
 - III. Claims 9-11, drawn to a method for manufacturing a tire characterized by formation of insert plies, classified in class 156, subclass 123.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, each invention has separate utility in formation of a tire without the other method, i.e. each can clearly be independently used. See MPEP § 806.05(d).
3. Inventions I/II and III seem to be essentially unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have not been described as usable together and relate to very different techniques – i.e. inventions I/II are related

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to winding rubber strips to form rubber tire layers whereas invention III is directed to specific formation of reinforcement plies by applying/winding reinforcing cords.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Dan Tanner on September 25, 2003 a provisional election was made with traverse to prosecute the invention of group I, claims 1-4. Affirmation of this election must be made by applicant in replying to this Office action. Claims 5-7 and 9-11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 refers to "two or more kinds of unvulcanized strips" being wound to form "a tire constitutive member" – this raises an ambiguity as it is not clear if the two strips form the same tire member (as would seem to be implied) or two different tire members (as apparently intended). It would seem from the original disclosure that the two

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different strips are intended to form two different tire members (e.g. 16 and 17 in fig. 1) and the claims will be interpreted in this manner for purposes of this office action but clarification is required.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Holroyd et al. (US 4,983,239) or Landsness (US 4,279,683) or DE 19831747 to Continental.

Holroyd et al. discloses a process for making a tire in which various components are wound and then joined to a toroidally shaped tire carcass (fig. 4). Further, the carcass has apparently been toroidally shaped from cylindrical form as typical (e.g. note col. 1, lines 9+), it being noted that even if it were not considered to be an explicit disclosure that the carcass is shaped from cylindrical form, such would have certainly been the natural and obvious technique to form the toroidal carcass in light of the col. 1, lines 9+ disclosure as well as the extremely common, well known and typical nature of such a building technique in which the tire is initially built on a cylindrical drum followed by expansion. Such is considered to clearly suggest (or certainly render obvious) a method as defined in claim 1. Further, it is noted that Holroyd indicates that the component(s) can be wound either a single or plural times to form the strip, it being noted that claim 1 makes no distinction in this regard. The suggestion to wind multiple turns to build up the material to form the component(s) is considered to clearly suggest a method consistent with claim 2. As to claim 3, note that the reference indicates that more than one kind of components can be formed. As to claim 4, the components include sidewall and chafer.

Similarly, Landsness discloses a process for making a tire in which the tread and sidewall may be wound and joined to a toroidally shaped tire green carcass (col. 1, lines 58+). Further, the carcass has apparently been toroidally shaped from cylindrical form as typical (e.g. note col. 1, lines 34+), it being noted that even if it were not considered to be an explicit disclosure that the carcass is shaped from cylindrical form, such would have certainly been the natural and obvious technique to form the toroidal carcass in

light of the reference to typical two stage building at col. 1, lines 34+ as well as the extremely common, well known and typical nature of such a building technique in which the tire is initially built on a cylindrical drum followed by expansion. Such is considered to clearly suggest (or certainly render obvious) a method as defined in claim 1. Further, it is noted that Landsness indicates that the strip is wound and overlapped plural times to form the component, such being considered to clearly suggest a method consistent with claim 2. As to claim 3, note that the reference indicates that more than one kind of components, i.e. the tread and sidewall, can be formed. As to claim 4, the components include sidewall.

Similarly, DE '747 to Continental discloses a process for making a tire in which the tread and sidewall may be wound and joined to a toroidally shaped tire green carcass (note esp. abstract and figures). It is not exactly clear whether the tire has been expanded from cylindrical shape although the abstract does reference that the carcass is at least partly *expanded*, this tending to imply that it was initially unexpanded. In any event, it is noted that even if it were not considered to be an explicit disclosure that the carcass is shaped from cylindrical form, such would have certainly been the natural and obvious technique to form the toroidal carcass in light of the reference to expansion as well as the extremely common, well known and typical nature of a building technique in which the tire is initially built on a cylindrical drum followed by expansion. Such is thus considered to clearly suggest (or certainly render obvious) a method as defined in claim 1. Further, DE '747 clearly indicates that the strip is wound plural times to form the component, it being considered that the ordinary artisan would have

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considered it to be inherent or in any event obvious that the strip would be overlapped over adjacent windings (this of course being almost necessary to form a profiled component), it being noted such would suggest/render obvious a method consistent with claim 2. As to claim 3, note that the reference indicates that more than one kind of components, i.e. the tread and sidewall (as well as apparently the belt), can be wound/formed. As to claim 4, the components include sidewall.

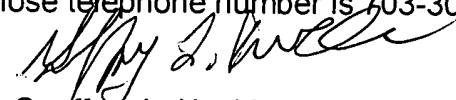
12. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 10-109506 to Sumitomo Rubber.

JP '506 discloses a process for making a tire in which the tire carcass is formed and toroidally shaped (figs. 3A, 3B) followed by winding/joining a strip to form part of the tire sidewall (note esp. figs. 2 and 4A). Such is considered to clearly suggest a method as defined in claim 1. As to claim 4, the wound component is part of the sidewall.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 703-308-2062. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.


Geoffrey L. Knable
Primary Examiner
Art Unit 1733

G. Knable
September 27, 2003